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Atty Dkt No. GP-303003 (GM-0363PUS)

Remarks

The following remarks are intended to be fully responsive to the Office Action mailed May 25, 2005.

Claims 8-10 and 15 are pending. Claim 15 is rejected under 35 U.S.C. § 112, first paragraph. Claims 8-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomas (872,829) in view of Mahrle (2,821,146). Claims 8, 10, and 15 have been amended. Claim 9 has been cancelled.

Rejection of Claim 15 under 35 U.S.C. § 112, first paragraph

Claim 15 has been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Amended claim 15 recites "causing a trolley having two roller elements to translate with respect to the I-beam whereby the two roller elements roll on the lower flange; *subsequent to said causing a trolley having two roller elements to translate* with respect to the I-beam, connecting a hanger to the upper flange of the I-beam; and *subsequent to said causing a trolley having two roller elements to translate* with respect to the I-beam, operatively connecting a rail to the hanger ..., the rail at least partially defining a passage and a track at least partially enclosed within the passage."

In rejecting claim 15 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, the Examiner states "the specific sequence of the method steps as recited in claim 15 is not found in the originally filed disclosure." "To comply with the written description requirement of 35 U.S.C. 112, para. 1, or to be entitled to an earlier priority date or filing date under 35 U.S.C. 119, 120, or 365(c), each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure." MPEP § 2163.

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Applicants respectfully submit that the subject matter of amended claim 15, and the sequence of method steps in particular, is found in the originally filed disclosure. The present application recites, at paragraph 0012, that the "material handling system 10 includes a horizontally oriented open-track I-beam 12 and is retrofitted to include an enclosed track rail 14 parallel to the I-beam." (emphasis added). A relevant definition of "retrofit" is "to modify equipment ... that is already in service using parts developed or made available after the time of original manufacture." (Webster's New Universal Unabridged Dictionary 1996) (emphasis added). Those skilled in the art will recognize that, as applied to an open-track I-beam, being "in service" means "causing a trolley having two roller elements to translate with respect to the I-beam whereby the two roller elements roll on the lower flange," as recited by claim 15. Further, paragraph 0002 of the present application states, with respect to open-track I-beams, that a "lower flange of the beam functions as a track on which the rollers of a trolley are engaged so that the trolley is translatable along the beam."

Thus, the present application discloses that a rail 14, which forms an enclosed track 34, is connected with respect to an open-track I-beam *after* the "lower flange of the beam functions as a track on which the rollers of a trolley are engaged so that the trolley is translatable along the beam."

Furthermore, the present application clearly states that the purpose of the hanger is to connect a rail defining an enclosed track to an I-beam: "A hanger for mounting an enclosed track rail to a beam is provided." (paragraph 0005 of the present application) (emphasis added). If the purpose of the hanger provided in the Applicants' disclosure is to mount an enclosed track rail to an I-beam, and since the context of mounting the rail to the I-beam is *retrofitting* the open-track I-beam to include the enclosed track rail, it therefore follows that the hanger is mounted to the I-beam *after* the I-beam is used as an open track with a trolley thereon.

With respect to the written description requirement, the "fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 USPQ2d at 1117." MPEP § 2163. Thus,

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Applicants respectfully submit that “causing a trolley having two roller elements to translate with respect to the I-beam ...; *subsequent to said causing a trolley having two roller elements to translate* with respect to the I-beam, connecting a hanger to the upper flange of the I-beam; and *subsequent to said causing a trolley having two roller elements to translate* with respect to the I-beam, operatively connecting a rail to the hanger,” as recited by claim 15, is supported by Applicants original disclosure, and therefore claim 15 complies with 35 U.S.C. § 112, first paragraph.

Rejection of Claims 8-10 under 35 U.S.C. § 103

Claims 8-10 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomas (827,829) in view of Mahrle (2,821,146).

Claim 8 has been amended to recite the elements and limitations of cancelled claim 9. More specifically, amended claim 8 recites, *inter alia*, “connecting a rail to the horizontally-oriented beam ... and wherein the method further comprises employing a cantilever to support the rail from the beam.” (emphasis added).

In rejecting claims 8-10, the Examiner admits that “Thomas does not have another rail connected thereto by mounting means as recited in the instant claims.” The Examiner further states that “Mahrle discloses a material handling system ... including ... element 20 readable as a hanger that connects beam 12 to rail P such that certain portions of the beam and of the rail have the same vertical height.”

Former claim 9, and amended claim 8, do not merely recite a “hanger” that connects a rail to a beam. Instead, former claim 9 and amended claim 8 recite “a cantilever to support the rail from the beam.” Applicants note that a “cantilever” is “a projecting beam or member supported at only one end.” (Webster’s New Collegiate Dictionary, 1976) (emphasis added). The Examiner does not address a “cantilever” specifically in the Office action. Moreover, element 20 of Mahrle, which the Examiner considers a “hanger,” is a “roof truss.” See Mahrle, column 2, line 18. There is no teaching or suggestion in Mahrle that roof truss 20 is “a projecting beam or member supported at only one end.” To establish *prima facie*

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obviousness, the prior art reference or references must teach or suggest all the claim limitations. MPEP § 2143. Accordingly, since neither Thomas nor Mahrle teaches or suggests a cantilever, *prima facie* obviousness is not established for former claim 9 and for amended claim 8. Accordingly, Applicants submit that claim 8 is allowable. Claim 10 depends from claim 8 and is therefore allowable for at least the same reasons that claim 8 is allowable.

Conclusion

The amendments and remarks in support of the rejected claims are believed to place this application in condition for allowance, which action is respectfully requested.

Respectfully submitted,

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